

P1-9894.A08

that item (2) on page 2 of the outstanding Official Action incorrectly states that the Supplemental Amendment was "filed on April 3, 2002", although the Supplemental Amendment was filed on May 1, 2002. Accordingly, Applicants respectfully request correction of the record. Additionally, Applicants respectfully request an acknowledgment of the claims for domestic priority on the Summary of the next Office Action.

In the outstanding Official Action, the Examiner rejected claims 14, 21 and 22 under 35 U.S.C. §103(a) over ANJO (U.S. Patent No. 5,046,014). In view of the herein-contained remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection of claims 14, 21 and 22.

In the outstanding Official Action, the Examiner asserted that "[i]t is the Examiner's opinion that although Anjo may not explicitly include these considerations, these aspects of programming are inherent since one of ordinary skill in the art typically programs the punching process to minimize down time, inter alia, as well as maximize the efficiency of any machining operation, especially a punching operation".

In this regard, claim 14 recites "said program preparing method prepares said program by feeding a punch identification information and a die identification information from said respective identification medium readers back to an automatic programming apparatus and by allotting a punch existing on said punch supporting member and a die existing on said die supporting member to a workplace region to be processed such that a total number of

P19894.A08

replacements of punches in said punch supporting member and dies in said die supporting member is minimized".

Applicants respectfully assert that the above-noted assertion by the Examiner is in error, at least because the above-noted features recited in the combination of claim 14 are not "inherent". In particular, the Examiner is requested to review MPEP Section 2112 regarding the burden of proof and requirements of a rejection based on inherency.

Under these guidelines, the Examiner must provide rationale or evidence tending to show that the missing descriptive matter is necessarily present in the reference. However, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981); Ex parte Skinner, 2 USPQ2d 1788 (BPAI 1986); Ex parte Keith and Turnquest, 154 USPQ 320 (B.O.A. 1966). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

Accordingly, while Applicants agree that a natural inclination of a programmer is generally to maximize the total benefits of a machining operation while minimizing the total costs, the definition and importance, or even the consideration, of a particular cost or benefit

•P1-9894.A08

may vary among different programmers. In this regard, Applicants submit that the above-noted features recited in claim 14 are not necessarily present in ANJO, nor is such a feature disclosed or suggested. Rather, a minimization of the replacements of punches in a punch supporting member and dies in a die supporting member, as recited, is only one of many factors that may or may not be considered in preparing a program for a punch press. For example, a program may be designed to minimize a total time spent replacing punches and dies, rather than a number of replacements of each punch and die. Alternatively, a program may be designed to minimize only a total number of die replacements, or a total number of punch replacements, or a total time to replace dies, or a total time to replace punches.

Additionally, as was previously recited, a program may be designed to minimize a total number of punches, or maximize the punch size of the tools, or maximize a measure of the flatness of the finished surfaces. Applicants further respectfully submit that the Examiner has already acknowledged the variety of alternative programming objects that can be achieved, in setting forth a Restriction Requirement wherein the Examiner asserted that various of the above-noted features in different claims are "divergent subject matter", subject to restriction (Official Action dated July 12, 2002). Therefore, Applicants respectfully submit that the Examiner has already admitted that the above-noted features of claim 14 are not "inherent" by asserting that many options exist for a programmer when designing a

Pr9894.A08

program. Additionally, Applicants submit that the Examiner has also admitted that the above-noted features of claim 14 are not disclosed or suggested by ANJO.

In the outstanding Official Action, the Examiner also indicated that "Anjo discloses the invention substantially as claimed except for a separate identification reader for the die. However, providing a separate reader is deemed to be an obvious addition to ANJO since the single medium reader as taught by ANJO is capable of reading media from both the punch and the die and since both a punch and die are of equal importance in ANJO due to the fact that in a punching operation, the punch and die work together to punch. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the method of Anjo with an additional reader, albeit for the die, for the reasons stated supra, and since it has been led that mere duplication of the essential working parts of a device involved only routine skill in the art".

In this regard, claim 14 recites "said punch press is provided with... a die identification medium reader for reading out a die identification information from a die identification medium attached to said die". Insofar as the Examiner has improperly asserted several bases to justify the above-noted rejection, Applicants respectfully submit that each of the above-noted assertions is in error.

In particular, if the Examiner is taking Official Notice of the above-noted features recited in claim 14, which are not disclosed or suggested by the applied art, Applicants

•Pt9894.A08

respectfully request that the Examiner provide a reference that discloses or suggests the features of claims 14, 21 and 22 which are admitted not to be disclosed or suggested by ANJO. MPEP 2144.03 provided guidelines governing the presentation of a reference upon request. Accordingly, Applicants respectfully submit that the above-noted features of claim 14 are not subject to "instant and unquestionable demonstration in the prior art". Accordingly, Applicants respectfully submit that it is inappropriate to take Official Notice of their existence.

Additionally, Applicants respectfully submit that the assertion that the "die identification medium reader for reading out a die identification information from a die identification medium attached to said die" recited in claim 14 is "mere duplication" of the recited "punch identification medium reader", is incorrect. In particular, merely duplicating the punch identification medium reader would provide a second punch identification medium reader, and not a die identification reader as recited in claim 14. Therefore, the assertion that a die identification medium reader is merely a duplication of an existing part, is incorrect. For all of the reasons noted above, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection of claim 14.

Applicants additionally submit that each of the dependent claims now pending is allowable, at least for depending, directly or indirectly, from an allowable independent claim, as well as for additional reasons related to their own recitations. Accordingly, for at least the

• P19894.A08

reasons noted above, Applicants respectfully request reconsideration and withdrawal of each of the outstanding rejections, as well as an indication of the allowability of each of the claims now pending, in due course.

SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have discussed the features recited in Applicants' claims and have shown how these features are not taught, disclosed nor rendered obvious by the reference cited by the Examiner. Accordingly, for each of the reasons noted herein, Applicants respectfully request reconsideration and withdrawal of each of the outstanding rejections, as well as an indication of the allowability of each of claims 14, 21 and 22, in due course.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

April 30, 2003
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

Respectfully submitted,
Takehiko SHIGEFUJI et al.


Bruce H. Bernstein
Reg. No. 29,027